

REMARKS

This Paper and Request for Continued Examination are submitted in response to the Advisory Action dated January 25, 2007 and in further response to the final Office Action dated November 27, 2006 having a shortened statutory response period ending on February 27, 2007. This Paper is submitted within the shortened statutory response period. The Commissioner is hereby authorized to charge the RCE fee of \$790.00 and any additional fees to Deposit Account number 02-1818.

Claims 1, 3, 5, 21-23, 25-28, 30, 37-39, 41-42, 44-47, 49-51, 57-58 and 77-80 are pending in this application. Claims 2, 10-20, 35, 48, 56 and 59-76 have been canceled. Claims 4, 6-9, 24, 29, 31-34, 36, 40, 43, and 52-55 have been withdrawn and may be rejoined upon allowance of a generic claim.

Claims 1, 3, 5, and 77-80 were rejected under 35 U.S.C. §112 1st paragraph as the claim term "exposing the interface area to infrared energy" was alleged to be not supported by the specification. The present claims have been amended to recite that the bond area is exposed to infrared energy. Claim 77 was rejected under 35 U.S.C. §112 1st paragraph as the term "to maintain a desired functional geometry of the bond area" was alleged to be not supported by the specification. Claim 77 has been amended to more clearly articulate the claimed subject matter. Applicants respectfully submit that these amendments neither narrow the scope of nor introduce new matter to these claims. In view of the foregoing, Applicants respectfully submit that the §112 rejections be withdrawn.

Claims 1, 3, 5, and 78 were rejected under 35 U.S.C. §102(b) for allegedly be anticipated by U.S. Patent No. 5,549,552 to Peters et al. (*Peters*). Claims 77, 79, and 80 were rejected under 35 U.S.C. §103(a) for allegedly being obvious in view of *Peters*. Claims 3, 21, 25-28, 30, 35, 37, 38, 41, 42, 44-47, 49-51, and 56-58 were rejected under 35 U.S.C. §103(a) for allegedly being obvious over *Peters* in view of *Holman*. Claims 21-23 and 39 were rejected under 35 U.S.C. §103(a) for allegedly being obvious over *Holman* in view of U.S. Patent No. 4,340,097 to Ammann et al. (*Ammann*). Applicants respectfully traverse and disagree with these rejections for the reasons set forth below.

Peters, *Holman*, and *Ammann*, either alone or in combination, fail to disclose or suggest a method for assembling a medical device that includes fitting a heat shield over a bond area, the heat shield permitting transmission of infrared energy to form a bond between two polymeric articles at the bond area as recited in the present claims. *Peters* teaches away from fitting a heat

shield over the bond area as recited in the present claims. Rather, *Peters* discloses a method for manufacturing a balloon catheter by heat bonding an inflatable balloon onto an inner tube. *Peters* is clear that the bonding area (*i.e.*, the balloon waist region) is exposed to heat while the nonbonding regions are covered with a heat shield to protect the non-bonding regions from the heat.

Prior to exposing the heat shrinkable tube and the bonding regions to heat from the heat source, a heat shield may be placed **on the balloon** such that **only** the bonding regions and the heat shrinkable tube are exposed to the heat.

Peters, col. 2 lines 64-67 (emphasis added). *Peters* reiterates that the bonding region (the balloon waist region) is exposed, with the heat shield covering the nonbonding regions of the balloon and the inner tube.

With the heat shrink tube 48a or 48b positioned over the distal balloon waist 39 and an appropriate heat shield positioned proximal therefrom, heat is applied to thermally bond the distal balloon waist 39 to the distal inner tube 34.

Peters, col. 8 lines 44-47. As *Peters* is clear that the heat shield does not cover the balloon waist region (the bonding region), *Peters* teaches away from the step of fitting a heat shield over the bond area as recited in the present claims. Teaching away is a *per se* demonstration of non-obviousness. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988). Consequently, any reference in combination with *Peters* is likewise *per se* non-obvious.

Even assuming *arguendo* that *Holman* and *Ammann* are combinable with *Peters* (which they are not as *Peters* teaches away from the present claims), *Holman* and *Ammann* fail to fulfill the deficiencies of *Peters*. *Holman* and *Ammann* have no disclosure whatsoever directed to a heat shield. A reference cannot disclose or suggest that which it does not have. In this case, *Holman*, and *Amman* are wholly silent with respect to a heat shield and thereby cannot disclose or suggest fitting a heat shield over an interface area as recited in the present claims. Therefore, no combination of *Peters*, *Holman*, and *Ammann* discloses or suggests the claimed subject matter.

Regarding claims 25 and 44, Applicants respectfully traverse and oppose the Examiner's attempt to assert official notice with respect to an infrared absorbing pigment printed onto a polymeric article. Indeed, the MPEP is clear that official notice without documentary evidence is permissible only in limited and rare circumstances. See MPEP §2144.03. The Examiner has proffered no evidence whatsoever that printing an infrared absorbing pigment on a polymeric

article is commonly known in the art. In view of the foregoing, Applicants respectfully traverse the Examiner's attempt to take official notice with respect to the step of printing infrared absorbing pigment onto the polymeric articles as recited in claims 25 and 44.

Applicants steadfastly traverse the species rejection. Applicants have clearly articulated how the dependent claims are not mutually exclusive as the pending claims are connected in design, operation, and effect. *See* Supplemental Response to Restriction Requirement dated March 21, 2006. The MPEP is clear that species under a claimed genus which are connected in design, operation, and effect are related and not mutually exclusive. MPEP §806.04(b). Applicants further clarified that since the pending claims are method claims, the practice of any claim does not mutually exclude the practice of any other claim in elected Group I. *See* Supplemental Response to Restriction Requirement dated March 21, 2006. Applicants therefore respectfully submit that it is the Examiner's obligation to show how the alleged species are mutually exclusive. Lacking such a showing, Applicants respectfully submit the species rejection is improper.

In the spirit of cooperation and in an effort to advance prosecution of this application, Applicants have withdrawn claims 4, 6, 7-10, 14, 16-20, 24, 29, 31-34, 36, 40, 43, and 52-55, with the understanding that these claims may be rejoined into this application upon the allowance of a generic claim.

For the foregoing reasons, Applicants respectfully request reconsideration of their patent application and earnestly request an early allowance of same.

Respectfully submitted,

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